



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/134,897      | 08/17/1998  | TOMOHARU TANAKA      | 0039-6348-2S        | 8591             |

22850 7590 07/07/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

TRAN, ANDREW Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2824

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

|                                |             |   |                     |
|--------------------------------|-------------|---|---------------------|
| APPLICATION NO/<br>CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR /<br>PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|--------------------------------|-------------|---|---------------------|

09/134,897 08/17/1998

|          |
|----------|
| EXAMINER |
|----------|

|          |       |
|----------|-------|
| ART UNIT | PAPER |
|----------|-------|

20060613

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Applicant is informed that the original claims are found allowable, and a divisional application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application, according to MPEP § 1450.

Andrew Q Tran  
Primary Examiner  
Art Unit: 2824

|                          |                                      |                                      |  |
|--------------------------|--------------------------------------|--------------------------------------|--|
| <b>Interview Summary</b> | <b>Application No.</b><br>09/134,897 | <b>Applicant(s)</b><br>TANAKA ET AL. |  |
|                          | <b>Examiner</b><br>Andrew Q. Tran    | <b>Art Unit</b><br>2824              |  |

All participants (applicant, applicant's representative, PTO personnel):

(1) Ex. Andrew Q. Tran. (3)\_\_\_\_\_.

(2) Mr. Raymond F. Cardillo, Jr. (4)\_\_\_\_\_.

Date of Interview: 14 June 2006.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: None.

Identification of prior art discussed: None.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.


Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant indicates that Divisional Applications for non-elected claims were filed.

*(see PAM printout attached)*

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

# Continuity Information for 09/134897

## Parent Data

09134897

is a reissue of 08308534 USP 5,570,315 issued 10/29/96

## Child Data

11451584 is a division of 09134897

11451585 is a division of 09134897

11451586 is a division of 09134897

11451587 is a division of 09134897

11451588 is a division of 09134897

11451589 is a division of 09134897

11451590 is a division of 09134897

11451591 is a division of 09134897

11451592 is a division of 09134897

11451593 is a division of 09134897

[Appn Info](#) [Contents](#) [Petition Info](#) [Atty/Agent Info](#) **Continuity Data** [Foreign Data](#) [Inventors](#) [Address](#) [Fees](#) [Post Info](#) [Pre Grant Pub](#)

Search Another: Application#   or Patent#    
PCT /  /   or PG PUBS #    
Attorney Docket #    
Bar Code #

To go back use Back button on your browser toolbar.

Back to [PALM](#) | [ASSIGNMENT](#) | [OASIS](#) | [Home page](#)

MPEP 1450

1450 [R-2] Restriction and Election of Species >Made in Reissue Application<  
37 CFR 1.176. Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications.

Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed

subject matter may be required (restriction involving only subject matter of the original patent claims

will not be required). If restriction is required, the subject matter of the original patent claims will be

held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue

application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between claims newly added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between the newly added claims and the original claims are the same as that applied in a non-reissue application. See MPEP §§ 806 through 806.05(i). The authority to make a "restriction" requirement under 37 CFR 1.176(b) extends to and includes the authority to make an election of species.

Where a restriction requirement is made by the examiner, the original patent claims will be held to be constructively elected (except for the limited situation where a disclaimer is filed as discussed in the next paragraph). Thus, the examiner will issue an Office action >in

the reissue application< (1) providing notification of the restriction requirement, (2) holding the added claims to be constructively non-elected and withdrawn from consideration, \* (3) treating the original patent claims on the merits >, and (4) informing applicant that if the original claims are found allowable, and a divisional application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application.<.

If a disclaimer of all the original patent claims is filed in the reissue application containing

newly added claims that are separate and distinct from the original patent claims, only the newly added claims will be present for examination. In this situation, the examiner's Office

action will treat the newly added claims in the reissue application on the merits. The disclaimer of all the original patent claims must be filed in the reissue application prior to the issuance of the examiner's Office action containing the restriction requirement, in order for the newly added claims to be treated on the merits. Once the examiner has issued the Office action providing notification of the restriction requirement and treating the patent claims on the merits, it is too late to obtain an examination on the added claims

in the reissue application by filing a disclaimer of all the original patent claims. If reissue applicant wishes to have the newly added claims be treated on the merits, a divisional reissue application must be filed to obtain examination of the added claims. Reissue applicants should carefully note that once a disclaimer of the patent claims is filed, it cannot be withdrawn. It does not matter whether the reissue application is still pending, or whether the reissue application has been abandoned or issued as a reissue patent. For all these situations, 37 CFR 1.176(b) states that the disclaimer cannot be withdrawn; the disclaimer will be given effect.

Claims elected pursuant to a restriction requirement will receive a complete examination on the merits, while the non-elected claims (to any added invention(s)) will be held in abeyance in a withdrawn status, and will only be examined if filed in a divisional reissue application. If the reissue application containing only original unamended claims becomes

allowable first (and no "error" under 35 U.S.C. 251 exists), further action in that reissue application will be suspended to await examination in the divisional reissue application(s) containing the added claims. >Multiple suspensions (usually six-month periods) may be necessary.< The Office will not \* >permit< claims >to issue< in a reissue application which >application< does not correct any error in the original patent. Once a divisional reissue application containing the added claims is examined and becomes allowable, \*\* >the examiner will issue a requirement under 37 CFR 1.177(c) for applicant to merge the claims of the suspended first reissue application with the allowable claims of the divisional

reissue application into a single application, by placing all of the claims in one of the applications and expressly abandoning the other. The Office action making this requirement will set a two-month period for compliance with the requirement. If applicant

fails to timely respond to the Office action, or otherwise refuses to comply with the requirement made, then the divisional reissue application (claiming the invention which was non-elected in the now-suspended first reissue application) will be passed to issue alone, since the claims of the divisional reissue application, by themselves, do correct an error in the original patent. Prosecution will be reopened in the suspended first reissue application, and a rejection based on a lack of error under 35 U.S.C. 251 will then be made. This rejection may be made final, since applicant is on notice of the consequences of not complying with the merger requirement.

If the divisional reissue application becomes abandoned, prosecution will be reopened in the suspended first reissue application, and a rejection based on a lack of error under 35 U.S.C. 251 will then be made in the first reissue application. Since no error in the original patent is being corrected in the first reissue application, no reissue patent will issue.<

As stated in 37 CFR 1.176(b), the examiner is not permitted to require restriction among original claims of the patent (i.e., among claims that were in the patent prior to filing the reissue application). Even where the original patent contains claims to different inventions which the examiner considers independent or distinct, and the reissue application claims the same inventions, a restriction requirement would be improper. If such a restriction requirement is made, it must be withdrawn.

Restriction between multiple inventions recited in the newly added claims will be permitted provided the added claims are drawn to several separate and distinct

inventions. In such a situation, the original patent claims would be examined in the first reissue application, and applicant is permitted to file a divisional reissue application for each of the several separate and distinct inventions identified in the examiner's restriction requirement.

A situation will sometimes arise where the examiner makes an election of species requirement between the species claimed in the original patent claims and a species of claims added in the reissue application. In such a situation, if (1) the non-elected claims to the added species depend from (or otherwise include all limitations of) a generic claim which embraces all species claims, and (2) the generic claim is found allowable, then the non-elected claims of the added species must be rejoined with the elected claims of the original patent. See MPEP § 821.04(a).

\*\*

---

#### 1451 [R-3] Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending

35 U.S.C. 251. Reissue of defective patents.

\*\*\*\*\*

The Director may issue several reissued patents for distinct and separate parts of the thing patented,  
upon demand of the applicant, and upon payment of the required fee for a reissue for each of such  
reissued patents.

\*\*\*\*\*

#### 37 CFR 1.177. Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one

application for the reissue of a single patent, each such application must contain or be amended to

contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322

any reissue patent resulting from an application to which this paragraph applies that does not contain

the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of

the patent being reissued must be presented in each of the reissue applications as an amended,

unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as

in the patent being reissued. The same claim of the patent being reissued may not be presented in its

original unamended form for examination in more than one of such multiple reissue applications. The